

REMARKS

Claim Status

Claims 1-38 are pending in the Application. Claims 1-37 were rejected as obvious pursuant to 35 U.S.C. § 103(a) over Mair (US 6,367,695). Claim 38 was restricted. Entry of the amendment is respectfully requested. No new matter has been added. Reconsideration is respectfully requested.

The Requirement

Applicants respectfully request reconsideration and clarification. It is unclear whether claim 38 is subject to species election requirement (as indicated in the Office Action dated February 23, 2005) or restriction requirement (as indicated in the present Office Action). As best understood, the species election requirement has been withdrawn and a restriction requirement has been newly imposed.

The current Action indicates that claim 38 is "restricted" based on the "fundamental mode of operation" of claim 38 being "to take user input to determine if the appearance of the ATM has changed." Applicants respectfully submit that what an Examiner may allege as a "fundamental mode of operation" of claim is not a proper criteria for establishing a requirement for restriction (or election). As the Office has not established a proper requirement, the (improper) requirement should be withdrawn.

Furthermore, where has the Office shown that the alleged "fundamental mode of operation" is prevented from being carried out in all of the other claims? For example, what prevents claim 26 from using "user input" in the same manner as claim 38? That is, the Office has not demonstrated independence (MPEP § 806.04(e)) nor mutual exclusivity (MPEP § 806.04(f)). Nor has the Office set forth the reasons for restriction requirement (MPEP § 817). Again, the Office has not established a proper requirement for either restriction or election. As the requirement has not yet been made final (MPEP § 821.01), Applicants respectfully traverse the requirement and request withdrawal thereof.

Applicants also respectfully request upon indication of claim allowance, the allowance of process claim 38 due to either of an allowed generic claim or rejoinder (MPEP § 806.04(d) and 821.04). Applicants further reserve all rights to present additional process claims.

The 35 U.S.C. § 103(a) Rejections

Claim 1

Mair does not teach or suggest having a radiation emitting device and a radiation sensing device with *both* being positioned adjacent the same card reader slot (e.g., Applicants' Figure 14). Mair's Figure 2 relates to a false keypad (21), not an unauthorized card reader. In Mair's Figure 3 the emitter (108) is specifically positioned operationally away from the card reader slot (12) for concealment behind the monitor screen (116) (e.g., col. 5, lines 29-31). As the applied prior art does not teach or suggest the recited features, the Office has not established a *prima facie* case of obviousness.

Furthermore, Mair structurally teaches against the recited invention. For example, note Mair's operational alignment of the detector (102) and the emitter (108) in Figure 3 (and the similar alignment in Figure 2). One having ordinary skill in the art would recognize that the size of Mair's detector (102) and emitter (108) would prevent their operational positioning adjacent to the card reader slot (12). That is, Mair not only lacks the recited apparatus and any suggestion for modification, but Mair is also not capable of being structurally modified to produce the recited apparatus. It follows that it would not have been obvious to one having ordinary skill in the art to have modified Mair to have produced the recited apparatus.

Also, Mair's detection arrangement can be easily evaded, such as by placing a fiber optic strand between the emitter and detector. However, with Applicants' exemplary arrangement, including having *both* the emitting device and the sensing device adjacent the card reader slot, such a strand would be useless because it would interfere with card entry into the slot. Thus, Applicants' exemplary form of the invention further distinguishes from Mair.

Mair is devoid of any teaching, suggestion, or motivation for combining features thereof so as to produce Applicants' recited invention. Applicants respectfully submit that in light of the failure of the solely applied reference to teach or suggest all of the recited features and relationships, combined with the lack of any other supporting evidence of record, the rejection is not valid. The record lacks evidential support for the rejection. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Claim 16

The claim 16 amendment finds support in original claim 4 and the Specification (e.g., page 26, lines 1-4). Mair does not teach or suggest having the emitting of radiation be dependent on prompting a user to move a card in a card reader slot. The Office has not established a *prima facie* case of obviousness.

Claim 19

The claim 19 amendment finds support in original claim 24 and the Specification (e.g., page 25, lines 8-13). Mair does not teach or suggest a radiation emitting device and a radiation sensing device mounted in supporting connection with a slot member. As previously discussed (e.g., claim 1 remarks), Mair does not teach or suggest *both* a radiation emitting device and a radiation sensing device positioned adjacent to the same card reader slot. The Office has not established a *prima facie* case of obviousness.

Claims 23 and 32

Mair does not teach or suggest using fuzzy logic, especially in comparing a stored value and a current value corresponding to a signal currently produced by a sensing device. It follows that Mair cannot produce an output responsive to a result of the comparison.

Although fuzzy logic may be known (e.g., Microsoft Computer Dictionary), where does Mair discuss or even mention using fuzzy logic, as alleged? Mair at the relied upon col. 5, lines 45-55, does not teach or suggest the recited features. Nor does Mair have a need of fuzzy logic. Conversely, Mair's alarm prevention is based on using a fixed "predetermined time interval" (col. 5, lines 49-50). The Office has not established a *prima facie* case of obviousness.

The Office's assertion of fuzzy logic in Mair is not based on any evidence in the record. However, the law requires that the evidence of record must teach or suggest the recited features in order to establish a valid rejection. *In re Zurko*, supra. *In re Lee*, supra.

Claim 26

The claim 26 amendment finds support in original claim 29. As previously discussed (e.g., claims 1 and 19 remarks), Mair does not teach or suggest *both* an emitting device and a radiation sensor device located adjacent to the same card reader slot, especially where the radiation sensor device is located adjacent the emitting device. The Office has not established a *prima facie* case of obviousness.

Claim 35

Mair does not teach or suggest capturing a card, especially in response to determining an unauthorized card reader. The Action asserts that "If the card is in the ATM when it is deactivated it would likely remain in the ATM." The assertion (along with the rejection) is based on "if", "likely", and pure speculation, not concrete evidence of record. *In re Zurko*, supra. If Mair's ATM is immediately deactivated upon indication of fraud (and before a card could even be used), then how could a card be captured? Even if it were somehow possible (for the sake of argument) for Mair to have a card "in the ATM when it is deactivated" (which Mair neither teaches or suggests), there would still be no teaching or suggestion that would prevent the card from being returned to the user prior to (or during) the deactivation. The Action does not factually support any *prima facie* conclusion of obviousness.

Claims 36 and 37

Mair does not teach or suggest cancelling an account, especially *responsive to* determining an unauthorized card reader. The Action's allegation that an ATM *user* in Mair would cancel their account "responsive to" determining an unauthorized card reader is without basis. Where does an ATM user in Mair *determine* an unauthorized card reader? Contrary, in Mair it is the *machine* that determines an unauthorized card reader. Further, *responsive to* Mair's ATM determining an unauthorized card reader, the ATM is deactivated. Where does Mair teach that the ATM even notifies an ATM user (or makes the user aware) of an unauthorized card reader? If Mair's ATM is immediately deactivated upon indication of fraud (and before a card can even be used), then why would an account need to be canceled? The Office has not established a *prima facie* case of obviousness.

For similar reasons Mair also does not teach or suggest monitoring activity on an account, especially *responsive to* determining an unauthorized card reader (claim 37). Again, the Office has not established a *prima facie* case of obviousness.

The statement in the Action that "This examiner has taken that kind of action in the past" is noted. The admission by the examiner of a previous improper action should have no bearing with regard to the current application.

Claim 38

Where does Mair teach or suggest determining whether an unauthorized object is an unauthorized card reader responsive to user input?

The Dependent Claims

Each of the dependent claims depends directly or indirectly from an independent claim. Thus, it is asserted that the dependent claims are allowable on at least the same basis. Furthermore, each of the dependent claims additionally recites specific features and relationships that patentably distinguish the claimed invention over the applied art. Mair does not teach or suggest the features and relationships that are specifically recited in the dependent claims.

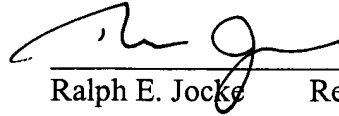
For example, Mair does not teach or suggest a radiation emitting device that emits visible light (e.g., claim 3). Conversely, Mair teaches against using visible light. Mair specifically teaches (col. 2, lines 36) using radiation that is invisible to humans, preferably infra-red radiation. Nor does Mair use visible light to both guide a user to the slot and sense an improper object (e.g., claims 11, 25, 33, and 34). Mair also does not teach or suggest the ability to compare a stored radiation property value with a current radiation property value (e.g., claims 6 and 30) to determine a difference (e.g., claims 7 and 8). Nor does Mair provide notice to an ATM user of a possible unauthorized reader device (e.g., claim 28). Thus, it is respectfully submitted that the dependent claims are further allowable due to the recitation of such additional features and relationships.

Conclusion

Applicants respectfully submit that this application is in condition for allowance.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. Jocke', is written over a horizontal line.

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